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EXAMINER

HUERTA, ALEXANDER Q

ART UNIT	PAPER NUMBER
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2623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/588,968		OKAMOTO ET AL.	
	Examiner		Art Unit	
	ALEXANDER Q. HUERTA		2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishi (United States Patent 6,681,395) in view of Tsuji et al. (United States Patent Application 2003/0065957), and in further view of Bonomi et al. (United States Patent 6,769,127), herein after referenced as Nishi, Tsuji, and Bonomi, respectively.

Regarding **claim 1**, Nishi discloses “a terminal body (integrated circuit interface 50) and a secure device (IC card 51) to be place in said terminal body [Col. 4 lines 35-42], wherein said secure device includes a membership information hold unit operable to hold membership information which is distributed to a membership user and indicates a group to which the user belongs” [Col. 4 lines 35-42, Figs. 1, 14, i.e. one of ordinary skill would recognize that the IC card would have storage so that it could retain the membership information, which meets the limitation "membership information hold unit"], and “a reproduction unit (subscriber terminal 4) to reproduce the content (program guide)...” [Col. 2 lines 5-20, Col. 4 lines 13-25, Fig. 1].

Nishi fails to explicitly disclose that “said terminal body includes: an operation mode setting unit operable to set an operation mode on the basis of the member ship information held by said member ship information hold unit”.

Tsuji discloses that “said terminal body includes: an operation mode setting unit (descramble key input unit 260) operable to set an operation mode on the basis of the member ship information held by said member ship information hold unit” ([0082], Fig. 2, i.e. the descramble key input unit makes a determination as to whether or a valid descramble key was entered thus authorizing a subscriber to view a pay channel). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an operation mode setting unit to set a mode of operation as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of authorizing subscribers to view of premium, pay channels.

However, both Nishi and Tsuji fail to disclose “...reproduc[ing] the content differently depending on the setting result given by said operation mode setting unit”.

Bonomi discloses “...reproduc[ing] the content (program guide) differently depending on the setting result given by said operation mode setting unit” [Col. 34 lines 20-40, Fig. 15C, i.e. the program guide displays only channels that the user is subscribed to]. Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of removing unsubscribed channels from the program guide as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of filtering the program guide so that only channel available to the subscriber are displayed thereby producing a more relevant program guide.

Regarding **claim 2**, Nishi discloses that “said reproduction unit has: a first storage unit operable to store a first application program for reproducing the content in a members-only operation mode” [Col. 4 lines 35-42, Figs. 1, 14, i.e. IC card that contains

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the membership information is inserted into the subscriber terminal, thereby providing the subscriber terminal with another storage unit].

Neither Nishi nor Tsuji disclose “a second storage unit operable to store a second application program for reproducing the content in a non-member operation mode; a selection unit operable to select one of the first application program and the second application program in accordance with the setting result; and an execution unit operable to execute the application program selected by the selection unit to reproduce the content, wherein the first application program is operable to cause said execution unit to execute a members-only decorative display”.

Bonomi discloses “a second storage unit operable to store a second application program for reproducing the content in a non-member operation mode [Col. 18 lines 23-25, Col. 34 lines 20-40, Figs. 2B, 15C, i.e. the program guide is downloaded to the client machine, which would require a storage unit to hold the program guide data in the client machine, which meets the limitation “second storage unit”]; a selection unit operable to select one of the first application program and the second application program in accordance with the setting result” [Col. 34 lines 20-40, Fig. 15C, i.e. one of ordinary skill in the art would recognize that the reproduction unit would have a selection unit to make a determination as to whether or not the user is a subscriber of premium channels so that the program guide can be adjusted accordingly], and “an execution unit operable to execute the application program selected by the selection unit to reproduce the content [Col. 34 lines 20-40, Col. 38 lines 6-9, i.e. it would be obvious that Bonomi would have a processor to facilitate the execution of implementing the custom program

guide], wherein the first application program is operable to cause said execution unit to execute a members-only decorative display” [Col. 34 lines 20-40, Fig. 15C].

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of providing a second storage unit, a selection unit to provide a suitable program guide that displays on subscribed channels, and an execution unit as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of filtering the program guide so that only channels available to the subscriber are displayed thereby producing a more relevant program guide.

Regarding **claim 3**, neither Nishi nor Tsuji explicitly disclose “the first application program is further operable to cause said execution unit to execute a members-only graphical user interface display”.

Bonomi discloses “the first application program is further operable to cause said execution unit to execute a members-only graphical user interface display” [Col. 34 lines 20-40, Fig. 15C, i.e. subscribers/members are allowed to view channels in the program guide to which they are subscribed]. Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of removing unsubscribed channels from the program guide as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of filtering the program guide so that only channel available to the subscriber are displayed thereby producing a more relevant program guide.

Regarding **claim 4**, Nishi discloses “said reproduction unit (subscriber terminal 4) has: a storage unit (nonvolatile memory 46) operable to store an application program for reproducing the content [Col. 4 lines 38-42, Fig. 1, i.e. one of ordinary skill would

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recognize that the controller 45 would have an operating software program to enable it to process and render the program guide]; “an execution unit (controller 45) operable to execute the application program to reproduce the content using the selected display data (EPG data)” [Col. 4 lines 38-42, Fig. 1].

Nishi fails to disclose “a selection unit operable to select one of first display data and second display data in accordance with the setting result and the first display data is used for a members-only decorative display, and the second display data is used for a non-member undecorative display”.

Bonomi discloses “a selection unit operable to select one of first display data and second display data in accordance with the setting result [Col. 34 lines 20-40, Fig. 15C, i.e. one of ordinary skill in the art would recognize that the reproduction unit would have a selection unit to make a determination as to whether or not the user is a subscriber of premium channels so that the program guide can be adjusted accordingly] and the first display data is used for a members-only decorative display, and the second display data is used for a non-member undecorative display” [Col. 34 lines 20-40, Fig. 15C, i.e. subscribers to the premium pay channels display a program guide containing all of the subscribed channels versus non-subscribers who display a reduced program guide displaying only basic channels].

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including a selection unit and providing an enhanced display for members as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of

filtering the program guide so that only the subscribers of premium channels receive the premium channel information in their program guide.

Regarding **claim 5**, Nishi fails to disclose that “the first display data further includes a members-only graphical user interface data”.

Bonomi discloses “the first display data further includes a members-only graphical user interface data” [Col. 34 lines 20-40, Fig. 15C, i.e. subscribers to the premium pay channels receive a program guide containing all of the subscribed channels versus non-subscribers who receive a reduced program guide displaying only basic channels]. Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of removing unsubscribed channels from the program guide as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of filtering the program guide so that only channels available to the subscriber are displayed thereby producing a more relevant program guide.

Regarding **claim 6**, Nishi discloses “said secure device (IC card 51) further includes a first storage unit operable to store a first application program for reproducing the content in a members-only operation mode [Col. 4 lines 35-42, Figs. 1, i.e. one of ordinary skill would recognize that the IC card contains member-only data (decode keys, channel subscription information, etc...) that enable the user to access member-only content and thus the IC card would have a storage unit].

Nishi fails to disclose explicitly disclose “said reproduction unit has: a second storage unit operable to store a second application program for reproducing the content in a non-member operation mode; a selection unit operable to select one of the first

application program and the second application program in accordance with the setting result; and an execution unit operable to execute the application program selected by the selection unit to reproduce the content, wherein the first application program is operable to cause said execution unit to execute a members-only decorative display”.

Bonomi discloses that “said reproduction unit has: a second storage unit operable to store a second application program for reproducing the content in a non-member operation mode” [Col. 18 lines 23-25, Col. 34 lines 20-40, Figs. 2B, 15C, i.e. the program guide is downloaded to the client machine, which would require a storage unit to hold the program guide data in the client machine, which meets the limitation “second storage unit”].

“a selection unit operable to select one of the first application program and the second application program in accordance with the setting result [Col. 34 lines 20-40, Fig. 15C, i.e. one of ordinary skill in the art would recognize that terminal device 110 would have a selection unit to make a determination as to whether or not the user is a subscriber of premium channels so that the program guide can be adjusted accordingly]; and an execution unit operable to execute the application program selected by the selection unit to reproduce the content [Col. 34 lines 20-40, Col. 38 lines 6-9, i.e. it would be obvious that Bonomi would have a processor to facilitate the execution of implementing the custom program guide], wherein the first application program is operable to cause said execution unit to execute a members-only decorative display” [Col. 34 lines 20-40, Fig. 15C]. Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of providing a selection unit to provide a

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suitable program guide that displays on subscribed channels as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of filtering the program guide so that only channels available to the subscriber are displayed thereby producing a more relevant program guide.

Regarding **claim 7**, Nishi fails to explicitly disclose that “said terminal body further includes an operation mode inquiry unit operable to inquire of said secure device about which operation mode is to be selected, and said secure device further includes an operation mode instruction unit operable to, when the inquiry is received, decide the operation mode on the basis of the membership information and to instruct said terminal body to operate in the decided operation mode, wherein said operation mode setting unit is operable to set the operation mode on the basis of the instruction as to the operation mode decided by the operation mode instruction unit”

Tsuji discloses that “said terminal body further includes an operation mode inquiry unit (control unit 210) operable to inquire of said secure device about which operation mode is to be selected” ([0072], [0073], [0078], [0086], Fig. 2, i.e. the control unit of the descramble module queries the IC card as to whether the IC card is valid and thus authorized to view premium channels), and said secure device further includes

“an operation mode instruction unit (control unit 110) operable to, when the inquiry is received, decide the operation mode on the basis of the membership information and to instruct said terminal body to operate in the decided operation mode ([0072], [0073], [0091], Figs. 1, 3, i.e. the control unit of the IC card instructs the descramble module to descramble the program signal on the basis of valid subscriber

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information), wherein said operation mode setting unit (descramble key unit 260) is operable to set the operation mode on the basis of the instruction as to the operation mode decided by the operation mode instruction unit" ([0082], Fig. 2, i.e. the descramble key input unit makes a determination as to whether or not a valid descramble key was entered thus authorizing a subscriber to view a pay channel).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an operation mode inquiry unit, operation mode instruction unit, and an operation mode setting unit as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of authorizing subscribers to view of premium, pay channels.

Regarding **claim 8**, Nishi fails to explicitly disclose that "said membership information hold unit is operable to hold a plurality of sets of membership information, and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including a set of membership information that is to be prioritized out of the plurality of sets of membership information".

Tsuji discloses "said membership information hold unit is operable to hold a plurality of sets of membership information ([0109], [0110], Fig. 4), and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including a set of membership information that is to be prioritized out of the plurality of sets of membership information" ([0107], [0109], Fig. 4, i.e. in this case the master registrant has a secret code enabling them to view pay channels, therefore giving them a higher authority over the other subscribers without a secret code).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an membership information hold unit to hold a plurality of sets of membership information and prioritizing said membership information as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of authorizing subscribers to view of premium, pay channels.

Regarding **claim 9**, Nishi fails to explicitly disclose that “the inquiry includes content information regarding the content to be reproduced, and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including the set of membership information to be prioritized out of the plurality of sets of membership information, on the basis of the content information included in the inquiry”.

Tsuji discloses “the inquiry includes content information regarding the content to be reproduced ([0072], [0073]), and said operation mode instruction unit is operable to, when the inquiry is received, decide the operation mode including the set of membership information to be prioritized out of the plurality of sets of membership information, on the basis of the content information included in the inquiry” ([0091], [0107], [0109], Figs. 1, 4, i.e. the subscriber with the secret code is authorized to view the pay channel versus subscribers without a secret code).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of deciding the operation mode on basis of inquiry as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of authorizing subscribers to view of premium, pay channels.

Regarding **claim 10**, Nishi fails to explicitly disclose that “said terminal body further includes an operation mode inquiry unit operable to inquire of said secure device about which operation mode is to be selected, and said secure device includes: a membership point storage unit operable to store a membership point given to the user; a rule storage unit operable to store a rule as to a membership status granted to the user according to a value of the membership point; and an operation mode instruction unit operable to, when the inquiry is received, decide the operation mode and the membership status on the basis of the membership information, the membership point, and the rule, and to instruct said terminal body as to the decided operation mode and the decided membership status, wherein said operation mode setting unit is operable to set the operation mode on the basis of the instruction as to the operation mode and the membership status decided by the operation mode instruction unit”.

Tsuji discloses that that “said terminal body further includes an operation mode inquiry unit (control unit 210) operable to inquire of said secure device about which operation mode is to be selected ([0072], [0073], [0078], [0086], Fig. 2, i.e. the control unit of the descramble module queries the IC card as to whether the IC card is valid and thus authorized to view premium channels to), and said secure device includes:

“a membership point storage unit (storage unit 120) operable to store a membership point” (secret identification code 125) given to the user ([0106], [0107], [0123], Fig. 4, 6, i.e. *Merriam Webster's Dictionary* defines a “point” as a distinguishing detail. The secret identification code distinguishes between subscribers, which allow those with the secret code to descramble pay channels);

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“a rule storage unit operable to store a rule as to a membership status granted to the user according to a value of the membership point” ([0127], [0128], Fig. 6, i.e. one of ordinary skill would recognize that Tsuji would have a rule storage unit to compare the user’s secret identification code and compare it with a valid code to ensure the user is authorized); and

“an operation mode instruction unit (control unit 210) operable to, when the inquiry is received, decide the operation mode and the membership status on the basis of the membership information, the membership point, and the rule, and to instruct said terminal body as to the decided operation mode and the decided membership status ([0072], [0073], [0074], Figs 1-3, 6), wherein said operation mode setting unit (descramble key input unit 260) is operable to set the operation mode on the basis of the instruction as to the operation mode and the membership status decided by the operation mode instruction unit” ([0082], Fig. 2, i.e. the descramble key input unit makes a determination as to whether or not a valid descramble key was entered thus authorizing a subscriber to view a pay channel).

Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an inquiry unit, membership point storage unit, rule storage unit, instruction unit, and a mode setting unit as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of authorizing subscribers to view premium, pay channels and preventing unauthorized users accessing restricted channels.

Regarding **claim 11**, Nishi discloses “said secure device is an IC card (IC card 51) [Col. 4 lines 35-43, Fig. 1].

Nishi fails to explicitly disclose that “said terminal body further includes an IC card slot into which said IC card is to be inserted, and wherein said operation mode setting unit is operable to set the operation mode on the basis of an insertion state of said IC card with respect to said IC card slot”

Tsuji discloses “said terminal body further includes an IC card slot into which said IC card is to be inserted” ([0074], Fig. 1), and wherein said operation mode setting unit (descramble key input unit 260) is operable to set the operation mode on the basis of an insertion state of said IC card with respect to said IC card slot” ([0082], Fig. 2, i.e. the descramble key input unit makes a determination as to whether or a valid descramble key was entered thus authorizing a subscriber to view a pay channel). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an IC card slot as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of enabling the user to insert and connect the IC card with the descramble module so that they may verify that they are authorized to view pay channels.

Regarding **claim 12**, Nishi discloses “a membership information hold step of holding membership information which is distributed to a membership user and indicates a group to which the user belongs, in the secure device;

Nishi fails to explicitly disclose “an operation mode setting step of setting an operation mode on the basis of the membership information held in said membership information hold step”

Tsuji discloses “an operation mode setting step (S42) of setting an operation mode on the basis of the membership information held in said membership information hold step” ([0150], [0151], [0152], Fig. 7, i.e. at step 42 it is determined if the subscriber is authorized to view pay channels). Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of including an operation mode setting unit to set a mode of operation as taught by Tsuji, to improve the IC card system of Nishi for the predictable result of authorizing subscribers to view of premium, pay channels.

The combination of Nishi and Tsuji fail to explicitly disclose “a reproduction step of reproducing the content differently depending on the setting result of said operation mode setting step, in the terminal body”.

Bonomi discloses “a reproduction step of reproducing the content differently depending on the setting result of said operation mode setting step...” [Col. 34 lines 20-40, Fig. 15C, i.e. the program guide displays only channels that the user is subscribed to]. Thus, it would have been obvious to one of ordinary skill in the art to apply the technique of removing unsubscribed channels from the program guide as taught by Bonomi, to improve the IC card system of Nishi for the predictable result of filtering the program guide so that only channel available to the subscriber are displayed thereby producing a more relevant program guide.

Regarding **claim 13**, claim 13 is interpreted and thus rejected for the reasons set forth above in the rejection of claim 12. Claim 12 describes a content reproduction method and claim 13 describes a program causing a computer to execute the method. Thus, claim 13 is rejected.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEXANDER Q. HUERTA whose telephone number is (571) 270-3582. The examiner can normally be reached on M-F(Alternate Fridays Off) 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on (571) 272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Alexander Q Huerta
Examiner
Art Unit 2623

August 1, 2008

/Scott Beliveau/

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Supervisory Patent Examiner, Art Unit 2623